

REMARKS

This responds to the Office Action mailed on April 18, 2006. No claims are amended, canceled, or added; claims 15-22 remain pending in this application.

1. Real Party In Interest

The real party in interest of the above-captioned patent application is the Assignee, eBay Inc.

2. Related Appeals and Interferences

There are no other appeals or interferences known to Appellants that will have a bearing on the Board's decision in an appeal of this matter.

3. Status of the Claims

Claims 15-22 are currently pending in this patent application. A Final Office Action was mailed on April 18, 2006. Claims 15-22 stand finally rejected, and their rejection is the subject of the appeal of this matter.

4. Status of Amendments

No claims have been amended.

5. Summary of Claimed Subject Matter

Independent method claim 15 relates to providing listing recommendations to users of a network-based commerce system (*see, e.g.*, Application at ¶ 7). In an embodiment, a plurality of listings is arranged in a plurality of divisions (*see, e.g.*, Application at ¶¶ 23, 27). The method identifies a division based on user interaction (*see, e.g.*, Application at ¶ 27), identifies at least one frequently used search term associated with the identified division (*see, e.g.*, Application at ¶ 27), and provides a link to the user to listings associated with the search term (*see* Application at ¶ 27).

6. Grounds for Rejection to Be Reviewed on Appeal

1) Was a *prima facie* case of anticipation under 35 U.S.C. § 102(a) properly made with respect to claims 15-22 using Spiegel et al. (hereinafter Spiegel) (U.S. Patent No. 6,466,918)?

7. Argument

A) *The Applicable Law*

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

B) *The References*

Spiegel: discloses a system for identifying popular nodes within a browse tree or other hierarchical browse structure based on actions of users (*see* Spiegel at Abstract).

C. *Discussion of the Rejections*

C.1 *The Rejection of claims 15-22 using Spiegel.*

Appellants respectfully submit that a *prima facie* case of anticipation of claims 15-22 has not been established because Spiegel fails to disclose all elements of the present claims.

Appellants cannot find in the cited portions of Spiegel any disclosure of “identifying at least one frequently used search term associated with the identified division; and providing a link to the user to listings associated with the at least one frequently used search term” as presently recited in claim 15.

Instead, Spiegel apparently describes identifying a popular node (e.g., a category or product) in a “browse tree,” where the node’s popularity may be based on various criteria. *See* Spiegel at col. 6, lines 5-29. For example, criteria used to indicate a category node’s popularity include “the number of purchases made within each category, the number of searches performed within each category, [and] click-through counts.” *See* Spiegel at col. 6, lines 21-26. However,

Spiegel apparently does not describe using frequently used *search terms* to identify popular nodes (e.g., categories or products). While, Spiegel does discuss the use of a “number of searches performed within [a] category” as an example of a criterion that may be used to indicate popularity, Appellants respectfully argue that the number of searches performed within a category node merely indicates the use or traffic within a category. It appears that frequently used search terms are simply not identified. In fact, the phrase “search term” does not appear in the Spiegel reference.

The Final Office Action attempts to provide an example of a frequently used search term by referencing the phrase “Olympics” as shown in FIG. 1A. *See* Final Office Action at ¶ 6. However, “Olympics” is a title of a category, not a search term as the Final Office Action asserts, listed under a “Featured Categories” header. *See* Spiegel at FIG. 1A; col. 7, line 12. Presumably, the “Olympics category” was promoted to its featured status based on a popularity score, as discussed above and as described in Spiegel at col. 7, lines 6-67. The popularity score may be a function of several factors, however, none of the factors described or disclosed in Spiegel include identifying frequently used search terms.

Moreover, after recognizing that “Olympics” is referring to a category, not a frequently used search term, Appellants respectfully argue that the Final Office Action’s assertion that Spiegel discloses “providing a link to the user to listings associated with the at least one frequently used search term” must also fail. While Appellants concede that hyperlinks are disclosed in Spiegel, and in fact the category “Olympics” may appear as a hyperlink in some embodiments, Appellants do not concede that such a hyperlink references a listing associated with at least one frequently used search term, as required by claim 15. In fact, it defies logic to conclude otherwise.

Regarding dependent claims 16-22, these claims depend from claim 15, either directly or indirectly, and are therefore believed to be patentable at least for the foregoing reasons. Thus, Appellants respectfully request withdrawal of the basis of rejection of these claims.

8. Summary

In sum, because the cited portions of Spiegel apparently do not disclose all elements recited or incorporated in claims 15-22, Appellants respectfully submit that there is no *prima*

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

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facie case of anticipation of these claims. Therefore, Appellants respectfully request reversal of all bases of rejection of all claims.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.


Respectfully submitted,

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Date June 19, 2006

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 19 day of June, 2006.

Peter Ruben
Name


Signature